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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,006	05/09/2002	Jan Hall	21547/0283	9722
7590 08/10/2005			EXAMINER	
Burton A Amernick Connolly Bove Lodge & Hutz PO Box 19088 Washington, DC 20036-0088			ROBERT, EDUARDO C	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/980,006	Applicant(s) HALL ET AL.	
	Examiner Eduardo C. Robert	Art Unit 3732	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 May 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 16-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5/9/02; 5/31/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/31/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

The drawings were received on 5/31/05. These drawings are acceptable.

### ***Claim Objections***

There exists an inconsistency between the language of claim 1 and that of the claim 4 dependent thereon, thus making the scope of the claims unclear. In the preamble of claim 2, line 1, applicant recites "A layer" with the implant functionally recited, i.e. "which can be arranged on an implant", thus indicating that the claim is directed to the subcombination, "A layer". However, in claim 4, lines 1-2, applicant positively recites the implant as part of the invention, i.e. "the layer is established on an undulating or uneven surface (3') present on the implant", thus indicating that the combination, layer and implant, is being claimed. As such, it is unclear whether applicant intends to claim the subcombination or combination. Applicant is hereby required to indicate to which, combination or subcombination, the claims are intended to be directed, and amend the claim such that the language thereof is consistent with this intent. For examination purposes claims 1-14, 20 and 21 will be considered as being drawn to the combination, layer and implant.

In claims 12 and 20 there is a problem similar to the one discussed above, and it would be treated in the same manner for examination purposes.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9, 12-15, and 19-21, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Hahn (U.S. Patent No. 3,605,123).

Hahn discloses a layer, e.g. 13 or 22, 32. The layer has a channel network with a porosity (see Figures 1-4). The channel network includes mouth which are adapted to face a bone structure (see for example Figures 2 and 3). As disclosed, the mouth cross section diameter are less than the an extends of the channel (see Figures 2 and 3). The channel network includes channel branches through the layer extending in all directions. The layer has a thickness up to 0.1 inch. It is noted that the range of 0.5-20 micrometers is within the range of Hahn. Hahn disclosed that the layer can be used on an implant, as shown in Figure 1, or could in any prosthetic device including anchoring element for attaching a teeth to a jawbone (see col. 5, lines 46-50). With regard the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Hahn which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference “teach” what the subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does

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not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10 and 11, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hahn (U.S. Patent No. 3,605,123).

Hahn discloses the claimed invention except for the diameter of the mouth being 0.1-10 micrometers (claim 10), the layer being of a titanium oxide (claim 11). With regard to claim 10, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the layer of Hahn with the diameter of the mouth being in the range of 0.1-10 micrometers, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. With regard to claim 11, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the layer of Hahn from titanium oxide, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

***Response to Arguments***

Applicant's arguments filed on 5/31/05 have been fully considered but they are not persuasive.

In response to applicant's argument that Hahn does not disclose a layer with a channel network that is substantial porous, it is noted that the Hahn layer is porous and the porous includes channels that extend from an outer surface of the layer to a direction of the implant. Now, with regard the recitation of the term "substantial", this clearly does not means -- all -- and as shown in Figures 2-4 the outer surface of the layer is substantially porous.

In response to applicant's argument that Hahn does not have mouths that face towards a surface of the layer with the cross-sectional diameter at the surface being less than the extension of the channel, it is noted that the porous on the outer surface of Hahn includes an opening that the opening is considered a mouth and this mouth or opening is face toward the outer surface of the layer, and as shown in the figure the pores includes channels that extend into the layer and some channels have a length larger than the diameter of the openings (see Figures 1-4).

In response to applicant's argument about claim 2, it is noted that what applicant is arguing is not in claim 2.

In response to applicant's argument about claim 16 (method claim), it is noted that this claims were withdrawn from consideration, thus it is irrelevant if Hahn discloses those claims or not.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 571-272-4719. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eduardo C. Robert  
Primary Examiner  
Art Unit 3732

E.C.R.